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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/639,051	08/11/2003	Robert F. Wallace	SNDK.154US3	6738

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EXAMINER

LUEBKE, RENEE S

ART UNIT PAPER NUMBER

2833

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/639,051	WALLACE	
	Examiner	Art Unit	
	Renee S. Luebke	2833	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/30/05</u> | 6) <input type="checkbox"/> Other: _____ |

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 10, 2004 (and March 30, 2005) has been entered.

Applicant is reminded that it is not necessary to refile an amendment-after-final along with the RCE. By definition, the amendment-after-final will be entered since the finality of the final rejection is withdrawn.

2. The amendment filed September 13, 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is the requirement that the claimed memory card is compatible with two different **structural** receptacles or card formats. Applicant's arguments are convincing with regard to electronic or media formats. However, applicant has not shown that the originally filed application included different structural formats. Applicant is required to cancel the new matter in the reply to this Office Action.

3. Regarding claim 14, the phrase "of a type" renders the claim indefinite, and is objected to, because the claim includes elements not actually disclosed (those encompassed by "type"), thereby rendering the scope of the claim unascertainable.

4. Claims 9 and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain

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subject matter, as indicated above, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

5. Claims 9 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Contrary to claim 9, the memory card does not comprise “means for contacting the memory card.” Applicant is correct in asserting that both the card and the device must comprise means for contacting. However, the “means for contacting the memory card” must be part of the device, not the memory card to which the claims are directed. Claims 9 and 10 appear to make reference to a number of different memory cards; if so, they should be clearly distinguished each time they are referenced.

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 5-7 remain rejected under 35 U.S.C. 102(e) as being anticipated by Sasaoka, et al. This rectangular card comprises a cut off corner and seven electrical contacts in recesses, defining the MMC standard. It also comprises additional contacts providing compatibility with other standards. The existence of additional contacts does not reduce the compatibility with the MMC.

Applicant’s arguments generally deal with the receptacle and compatibility therewith. However, these claims are drawn solely to the memory card. The card is compatible with any and all receptacles that are intended to

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be compatible with it. However, this compatibility does not impose and explicit or implicit limitations on the card itself.

8. Claims 8, 9 and 10 as best understood, 11, 12 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Sharp, et al. This memory card comprises a contact structure 210, 212 compatible for use in a first electronic device (at 212) and in a second electronic device (at 210).

Applicant argues that Sharp is not a memory card as claimed since it is too large. However, the size is not claimed. Further a card including ROM and function circuitry is seen to sufficiently meet the title of a memory card. Applicant has not indicated any claimed limitations that are absent from the device of Sharp.

Applicant further argues that Sharp does not teach all of the limitations of claim 5. However, claim 5 is not included in the rejection based on Sharp and the claims that are rejected as being anticipated by Sharp do not include the limitations found in claim 5.

Finally, in regard to claim 14, applicant appears to suggest that the device of Sharp is not "compatible with both MMC card receptacles and SD card receptacles." However, "compatible" is an extremely broad term and given appropriate programming, etc. any two cards are compatible. In addition, assuming applicant is correct in stating that the card of Sharp is only usable in a CPU, its contact structure is certainly compatible with a card receptacle which is also located in the CPU.

9. Claim 13 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Sharp. Applicant has not separately argued the limitations of this claim.

10. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been

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finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination (RCE) and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. It is suggested that responses to this final action be faxed to:
(703) 872-9306

Please refrain from sending a confirmation copy, as noted in 37 CFR 1.6(d) and 1.8(b).

Alternatively, responses may be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mrs. Renee Luebke at (571) 272-2009. If attempts to reach the examiner by telephone are unsuccessful, the

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examiner's supervisor, Mrs. Paula Bradley, can be reached at (571) 272-2800, extension 33.

A handwritten signature in black ink, appearing to be 'RSL', written over the printed name.

Renee S. Luebke
Primary Patent Examiner
May 26, 2005